

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*T-D*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/526,602    03/16/00    SUDA    Y    54490-Z/JFW/

JOHN P WHITE  
COOPER & DUNHAM LLP  
1185 AVENUE OF THE AMERICAS  
NEW YORK NY 10036

IM62/1206

EXAMINER

RODEE, C

ART UNIT	PAPER NUMBER
----------	--------------

1753

DATE MAILED:

12/06/00

*3*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/526,602

Applicant(s)

Suda et al.

Examiner

Christopher RoDee

Group Art Unit

1753



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 14-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 14-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/911,616.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1753

## **DETAILED ACTION**

### ***Claim Objections***

Claims 19 and 20 are objected to under 37 CFR 1.75(c) because they are dependent upon canceled claim 5. It appears that these claims should be dependent upon claim 18. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New independent claim 14 contains limitations not described by the specification as originally filed. The claim states that "the SP (solubility parameter) value of said solvent being adjusted to control the particle diameter of toner particles based on a difference between the SP value of the resin itself and the SP value of the solvent."

Basis for this limitation appears to be derived from specification pages 3 and 8. Specification page 3 states that the thermoplastic resin is dispersed "in a solvent having a high temperature dependency in its capability of dissolving the thermoplastic resin and having its

Art Unit: 1753

solubility parameter adjusted for controlling the size of the toner particles." Specification page 8 goes into more detail concerning the solubility parameter, stating "a differential SP value ( $\Delta SP$ ) between the SP value of the resin itself and that of the solvent should be as small as possible for diminishing the toner particle diameter. The passage on page 3 does not address the solubility parameter of the resin, only that of the solvent. On page 8, the specification relates the difference between the resin and solvent solubility parameters as being "as small as possible" to diminish the toner particle diameter. This is the only passage in the specification that addresses the difference in resin and solvent solubility parameters.

The new claims include within their scope the situation where the difference in solubility parameters is other than small (e.g., large) and where the particle diameter control is such that the toner particle diameter is other than a "diminished" one (e.g., larger). The specification fails to describe these other characteristics included within the scope of the claims. New matter is present. Note: Applicants are advised that the specification language may not be suitable to meet the requirements of § 112, second paragraph, should the claims be amended to adopt the limitations of the specification.

The specification as filed also fails to describe the thermoplastic resin as being melted, as presented in claim 14. Heating of a thermoplastic resin does not necessarily result in melting. For example, the thermoplastic resin could be softened, but not actually melted. If there is basis in the specification for melting of the resin, applicants are asked to refer the Examiner to the appropriate page and line of the specification.

The specification also does not appear to describe the addition of inorganic fine particles "so as to permit toner particle precipitation". Although the particles are added before particle precipitation, the specification does not appear to describe the inorganic fine particles as

Art Unit: 1753

permitting toner particle precipitation. Again, if there is basis for the claim language applicants are asked to refer the Examiner to the appropriate page and line in the specification.

New claims 18 and 19 are not described by the specification because the specification does not disclose a "charge controller". The specification does describe an "antistat" (pp. 9-10), but it appears that "antistat" is limited to a specific component that reduces or eliminates a static charge while a charge controller includes a compounds that increases or otherwise modifies a charge (e.g., changes the charge polarity; see Diamond § 6.2.3). The terms are not synonymous and "charge controller" is broader than "antistat".

***Conclusion***

The art of record does not disclose or suggest the invention as currently claimed. Specifically, the art does not suggest the addition of the inorganic particles at the specified point "immediately before initiation of the toner particle precipitation" having the effect noted. The art cited in the parent application has been reviewed in addition to the new art cited herein.

Any inquiry concerning this communication should be directed to Exr. Christopher RoDee at telephone number 703 308-2465 or via the receptionist at 703 308-0661 for general or status inquiries. Submissions by fax may be accepted at the following telephone numbers:

Official fax: 703 872-9310  
After Final fax: 703 872-9311  
Unofficial fax: 703 305-6078



**CHRISTOPHER RODEE  
PRIMARY EXAMINER**

cdr  
30 November 2000